REMARKS

Claims 1-30 were originally filed in the present application.

Claims 1-30 are pending in the present application.

Claims 1-30 were rejected in the April 21, 2006 Office Action.

No claims have been allowed.

Claims 1-30 remain in the present application.

Reconsideration of the claims is respectfully requested.

In Section 1 of the April 21, 2006 Office Action, the Examiner provisionally rejected Claims 1-30 under the judicially created doctrine of obviousness-type double patenting over co-pending Claims 1-24 of U.S. Patent Application No. 10/763,483 ("the '483 Patent Application"). Applicants respectfully disagree.

The Examiner admits that the allegedly conflicting claims are not identical. However, the Examiner goes on to suggest that the two applications are not patentably distinguishable because:

> they both teach controlling the use of a reduced cycle mode of a mobile station. The only difference in the claim sets is that the mobile station sends the reduced slot cycle index value request in a first release order message as opposed to sending it in a page response message.

The Examiner has merely compared the language of the claims of the present application with that of the '483 Patent Application and made conclusory statements in support of the rejection. The Examiner has failed to state or allege (1) the differences between the inventions as *defined by the allegedly conflicting claims*; and (2) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim presently at issue would have been an *obvious*

variation of the invention defined in the cited patent application. MPEP §804, p. 800-21 (8th ed., rev. 3, August 2005) (*emphasis added*).

The analysis employed in an obviousness-type double patenting rejection parallels the guidelines for the analysis of a 35 U.S.C. §103 obviousness determination. *Id.* Thus, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. *Id.* at 2100-133. Absent such a *prima facie* case, Applicants are under no obligation to produce evidence of nonobviousness. *Id.* To establish a *prima facie* case of obviousness, three basic criteria must be met. *Id.* First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. *Id.*

Without the requisite support, Applicants traverse the provisional double-patenting rejection and request favorable reconsideration and the withdrawal of the obviousness-type double patenting rejection.

In Sections 2 and 3 of the April 21, 2006 Office Action, the Examiner rejected Claims 1-30 as being anticipated by U.S. Patent No. 6,822,973 to *Kelley, et al.* (the "Kelley reference"). Applicants respectfully disagree.

Independent Claims 1, 8, 14, and 24 all require that a "first Release Order comprising a minimum reduced slot cycle index (SCI) value." The Kelley reference fails to disclose, for example, any system in which a *minimum* reduced slot cycle index value is used. At most, the Kelley reference teaches that a base station 108 may respond to a mobile station 102 by acknowledging that it supports a *reduced slotted mode*. There is no teaching or disclosure of any minimum reduced slot cycle index. Accordingly, the Kelley reference fails to anticipate Claims 1, 8, 14 and 24, and their dependents, Claims 2-7, 9-13, 15-19 and 24-30, respectively..

Independent Claim 20 requires that while the mobile station is operating in the reduced slot cycle mode, "the reduced slot cycle controller responds to the triggering event by causing the message controller to transmit to the first base station a first Release Order message comprising a normal slot cycle index (SCI) value requested by the mobile station". The Kelley reference fails to disclose, for example, any system that *responds to a triggering event by transmitting a first Release Order message comprising the normal SCI requested by the mobile station*. At most, the Kelley reference teaches that if an event has occurred to cause the base station 108 to cease reduced slotted mode, base station 108 simply clears the reduced slotted timer and resumes normal operations. There is no teaching or disclosure of any first Release Order message comprising normal SCI requested by the mobile station after the mobile station, operating in a reduced slot cycle mode, experiences a trigger event. Accordingly, the Kelley reference fails to anticipate Claim 20 and its dependents, Claims 21-23.

Applicants therefore request favorable reconsideration and the withdrawal of the §102

rejection of Claims 1-30.

SUMMARY

For the reasons given above, Applicants respectfully request reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckbutrus.com*.
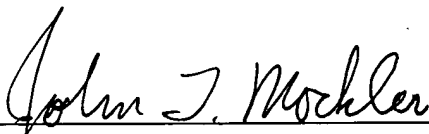
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

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John T. Mockler
Registration No. 39,775

P.O. Drawer 800889
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: *jmockler@munckbutrus.com*